

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MARC PAULY,
PHILIPPE MOSER, and
VERONIQUE GILLON

Appeal No. 2005-0976
Application No. 10/203,228

ON BRIEF

Before ELLIS, ADAMS, and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 5-20. Claims 5 and 13 are representative of the subject matter on appeal, and reads as follows:

5. An aqueous cosmetic composition comprising:
 - (a) an extract of *Waltheria indica*; and
 - (b) an acid component selected from the group consisting of ascorbic acid, ferulic acid, kojic acid, and mixtures thereof.
13. A process for inhibiting melanin formation in human skin comprising contacting the skin with an aqueous composition containing:

(a) an extract of *Waltheria indica*; and

(b) an acid component selected from the group consisting of ascorbic acid, ferulic acid, kojic acid and mixtures thereof.

The examiner relies upon the following references:

Bartolone et al. (Bartolone)	6,153,177	Nov. 28, 2000
Pauly et al. (Pauly)	6,406,720	Jun. 18, 2002

Claims 5-20 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Pauly and Bartolone. After careful review of the record and consideration of the issue before us, we reverse.

DISCUSSION

Pauly is relied upon for teaching “a cosmetic composition that contains *Waltheria indica* (see claims). The cosmetics whiten the skin by inhibiting tyrosinase (see Table 1, columns 11 and 12).” Examiner’s Answer, page 3. Bartolone is relied upon for teaching the use kojic acid, ferulic acid and ascorbic acid to whiten the skin, and for teaching that the inhibition of tyrosinase whitens the skin by inhibiting the formation of melanin. See id.

According to the rejection:

These references show that it was well known in the art at the time of the invention to use the claimed ingredients in cosmetic whitening compositions. It is well known that it is prima facie obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. . . .

Based on the disclosure by these references that these substances are used in cosmetic skin whitening compositions, an artisan of ordinary skill would have a reasonable expectation that a combination of the substances would also be useful in creating cosmetic skin whitening compositions. Therefore, the artisan would have been motivated to combine the claimed ingredients into a single composition. No patentable invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients.

Id. at 3-4 (citations omitted).

Appellants argue that, based on the teachings of the Pauly reference, one of ordinary skill in the art would not be motivated to include *Waltheria indica* in a skin whitening composition as “based on this reference’s teaching it would serve no skin whitening purpose.” Appeal Brief, page 3. We agree.

“A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, all facts must be considered. The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis. To the extent the Patent Office rulings are so supported, there is no basis for resolving doubts against their correctness. Likewise, we may not resolve doubts in favor of the Patent Office determination when there are deficiencies in the record as to the necessary factual bases supporting its legal conclusion of obviousness.” In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. Denied, 389 U.S. 1057 (1968) (emphasis in original).

The motivation to combine the *Waltheria indica* extract as taught by the Pauly reference with an acid component selected from the group consisting of ascorbic acid, ferulic acid, kojic acid as taught by the Bartolone reference as set forth in the rejection is based solely on the argument that “[i]t is well known that it is prima facie obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose [skin whitening] in order to form

a third composition which is useful for the same purpose.” Examiner’s Answer, page 3. Pauly, however, provides no teaching or suggestion to include *Waltheria indica* extract in a skin whitening composition. Pauly teaches the use of *Waltheria indica* extract in cosmetic compositions with enhanced anti-elastase action, strong anti-collagenase action, as well as strong anti-UVA and anti-UVB effect. See Pauly, col. 2, lines 4-27. When it comes to enhanced “anti-tyrosinase action, including a better de-pigmenting effect than current de-pigmenting ingredients, the active ingredient incorporated in it is advantageously at least one plant extract chosen from the group formed by *Spondias mombin*, *Maprounea guianensis* and *Gouania blanchetiana*.” See id. at col. 2, lines 28-34.

The examiner relies on Table 1 of the Pauly reference, arguing that the table demonstrates that *Waltheria indica* has “a strong ability to inhibit tyrosinase,” asserting that “it is the third strongest of nine plant tests,” and that “[o]nly these three strongest have more anti-tyrosinase activity than the control anti-tyrosinase substance hydroquinone.” Examiner’s Answer, page 5. But as noted by appellants, Table 1 demonstrates that concentration of the *Waltheria indica* extract “is about 5 times the concentration of the more effective extracts and about 3 times the concentration of the standard hydroquinone.” See Reply to Examiner’s Answer, page 2. Thus, based on the fact that the Pauly reference does not suggest the use of *Waltheria indica* extract in a de-pigmenting composition, and Table 1 of that reference demonstrates that it is *Waltheria indica* extract does not have strong anti-tyrosinase activity, and in fact not performing as well as the hydroquinone standard, Pauly provides no teaching or suggestion of using *Waltheria indica* extract in a whitening cosmetic composition, we are constrained to reverse the obviousness rejection given the examiner’s reasoning for the combination.

OTHER ISSUES

Upon return of the application, there are two additional issues the examiner may wish to consider.

First, on page 2 of the instant specification, appellants state that *Waltheria indica* is a known skin whitening agent. That statement by appellants does not appear to have been explored on the record as whether or not it may be considered an admission of fact.

Second, The Bartolone reference teaches that the disclosed skin lightening compositions, which may include kojic acid, ascorbic acid, or ferulic acid, may also comprise antiaging compounds. See Bartolone, Col. 2, lines 38. Pauly then teaches that *Waltheria indica* extract may be used in an antiaging cosmetic composition. See Pauly, col. 15, example 5. The examiner may wish to explore whether that comprises a sufficient motivation to combine the references.

CONCLUSION

Because the examiner failed to set forth a prima facie case of obviousness, the rejection under 35 U.S.C. § 103(a) is reversed.

REVERSED

Joan Ellis)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
Donald E. Adams)	
Administrative Patent Judge)	APPEALS AND
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